

**Notice of Allowability**

Application No.

10/825,632

Applicant(s)

ABBOTT ET AL.

Examiner

Art Unit

Sheridan L. Swope

1656

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment of May 5, 2006.
2. ☒ The allowed claim(s) is/are 1,3-5,7 and 8.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/070,464.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date May 5, 2006
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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### **DETAILED ACTION**

Applicant's amendment filed May 5, 2006, cancelling Claim 2 and amending Claims 1, 3, 4, and 6-8, is acknowledged. Claims 1 and 3-8 are pending. Claims 1 and 3-8 encompass a single invention, directed to a nucleic acid molecule encoding a dipeptidyl peptidase, and are hereby considered.

#### ***Priority***

The priority date for SEQ ID NO: 1 is taken to be September 10, 1999, the filing date of AU PQ2762, while the priority date for SEQ ID NO: 2 is taken to be February 18, 2000, the filing date of AU PQ5709.

#### ***Relevant Art***

The EST database, Accession number AA496257 (18-AUG-1997), discloses a sequence consisting of residues 2625-3119 of SEQ ID NO: 2. However, the polypeptide encoded by said sequence does not comprise the catalytic Ser739 of SEQ ID NO: 2, and thus would not have dipeptidyl peptidase activity. Therefore, the polynucleotide of EST database Accession number AA496257 is not prior art.

#### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

### *Specification*

Replace the first paragraph of the specification with the following:

–This application is a division of U.S. Patent Application Serial No. 10/070,464, filed on July 18, 2002, now US patent 6,881,564, which is the National Stage of PCT/AU00/01085, filed on September 11, 2000, the disclosures of which are incorporated herein by reference.–

### *Claims*

Cancel Claim 6

Replace Claims 1 and 5 with the following:

1. An isolated nucleic acid molecule selected from the group consisting of:

- (a) a nucleic acid molecule that encodes the sequence shown in SEQ ID NO: 1;
- (b) a nucleic acid molecule that consists of the sequence shown in SEQ ID NO: 2; and
- (c) a nucleic acid molecule that is capable of hybridizing to a nucleic acid molecule consisting of the sequence shown in SEQ ID NO: 2 under highly stringent conditions of washing with 0.1 x saline-sodium citrate (SSC)/ 0.1% sodium-dodecyl sulfate (SDS) at a temperature of 50°C, wherein the nucleic acid molecule encodes a peptide that has the dipeptidyl peptidase substrate specificity of the sequence shown in SEQ ID NO: 1.

5. A fragment of a nucleic acid molecule consisting of the sequence shown in SEQ ID NO: 2, wherein the fragment encodes a peptide that has the dipeptidyl peptidase substrate specificity of the sequence shown in SEQ ID NO: 1.

Authorization for this examiner's amendment was given in a telephone interview with Bob Ross on July 18, 2006.

***Allowable Subject Matter***

Claims 1, 3-5, 7, and 8 are allowed.

The following is an examiner's statement of reasons for allowance:

All elected Claims, 1, 3-5, 7, and 8, are limited to an isolated nucleic acid molecule as well as vectors and host cells comprising the nucleic acid molecule, wherein the nucleic acid molecule is SEQ ID NO: 2, encodes SEQ ID NO: 1, or is a variant of SEQ ID NO: 2 encoding a polypeptide having the dipeptidyl peptidase substrate activity of SEQ ID NO: 1. The utility of the nucleic acid molecule of SEQ ID NO: 2, as encoding a dipeptidyl peptidase (DPP8/SEQ ID NO: 1; Fig 2), is credible based on expression in heterologous host cells and analysis by an enzymatic assay (Table 1, Fig 7, and pg 31-32). Since the polypeptide of SEQ ID NO: 1 is a post-proline dipeptidyl amino peptidase (Table 1, Fig 7; Abbott et al, 2000), said polypeptide would have real-world use in peptide mapping and sequencing.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Lee Swope, Ph.D.  
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SHERIDAN SWOPE, PH.D.  
PRIMARY EXAMINER